



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,721	12/29/2000	John Brixius	3499-84	8324
27383	7590	12/14/2004	EXAMINER	
CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER

3624

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,721

Applicant(s)

BRIXIUS, JOHN

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10,11, 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 10 recites the step of transmitting an instruction to a transfer agent..to covert physical restricted securities into an electronic format. However, this step does not functionally relate to any process step of parent claim 1 and therefore the scope of the claim cannot be positively ascertained. This analysis also applies to dependent claim 11.

4. claims 12 and 16 recite limitation "receive a legal opinion document related to the trade". It is unclear as to the relationship of this limitation to the step of receiving "electronic authorization" and/or the "transmit" step. Dependent claims inherit same weakness.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 9-18 and 22-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shields et al. (US 2002/0042771) (Shields).

Note numbers shown in [] brackets are paragraph numbers referred to in the cited reference.

As per claim 1 Shields discloses a computer-implemented method for processing restricted securities trades via a communications network, the method comprising:

receiving data relating to restrictions associated with the trade of a security;

Art Unit: 3624

[0097] ..various types of RSA plans that can be accessed by the participant employees via the Internet or an IVR system and [0098] and [0098] .. restricted stock grant information

receiving electronic verification that the data is correct;
automatically generating documentation supportive of the
trade; and

receiving an electronic signature to execute the generated documents.

[0014] ..a check and journal process associated with a system for administering at least one employee stock plan. The system includes a computer-implemented finance system for processing a transaction pursuant to the employee stock plan including a volatile data storage for storing participant information pursuant to a data transfer from a nonvolatile database of a third party administration system; and an interface system for interacting with participants regarding requested transactions..

[0086] interface system 38 provides the participant 10 the option to request an authorization form 160, e.g., by providing telephone touch key selections or, as shown in FIG. 5 for a web-based system, presenting selectable hypertext links on a display that allow the participant to complete and submit the form online, and capture an online signature.

Claim 2: wherein the trade comprises a simple restricted sale.

See [0014] .. a transaction pursuant to the employee stock

Art Unit: 3624

Claim 3: additionally comprising the step of transmitting an instruction to execute the trade.

[0063] Trading system 12 accepts participant orders from finance system 4 and immediately forwards these to an exchange 28 for execution.

Claim 4: The method of claim 3 additionally comprising forwarding trade information to a clearing house.

See claim 3 analysis an exchange also performs settlement of trades i.e. clearing

Claim 5: The method of claim 1 wherein the data relating to the restrictions comprises a checklist of questions related to restrictions.

See [0086] ..authorization form 160.

Claim 9. The method of claim 1 additionally comprising the step of receiving edits to the generated documentation.

[0086] presenting selectable hypertext links on a display that allow the participant to complete and submit the form online, and capture an online signature. FIG. 5 is a display of a web-based interface system illustrating an authorization form request window.

Per Claim 12 Shields discloses a computer system for facilitating trading of a restricted security, the system comprising:

a computer server accessible wllll a network access device via a communication network;

Art Unit: 3624

[0050] FIG. 1 illustrates an employee stock plan system 2. Stock plan system 2 comprises a finance system 4, a communication system 8 that connects a participant 10 to finance system 4 and a trading system 12 for the trading of individual transactions on a public exchange 28. [0054] Communication system 8 provides a means by which a participant 10 interacts with finance system 4. Communication system 8 may be provided in the form of a telephonic communication, the Internet, or through an Intranet interface, e.g., operated by employees of the financial services organization that runs the finance system 4.)

and

executable software stored on the server and executable on demand, the software operative with the server to cause the system to:

transmit data relating to a restricted securities trade;

(see claim 1 analysis)

receive a legal opinion document related to the trade;

[0066] In accordance with the invention, "participant information" may pertain to client employer-related participant-specific information.. proceeds distribution instructions, tax payment instructions, and whether or not the participant is considered an insider pursuant to the New York Stock Exchange constitution and rules and/or

Securities and Exchange Commission (SEC) code.

receive electronic authorization to proceed with the trade;

and

Art Unit: 3624

transmit a command to execute trade.

(see claim 1 analysis)

Claim 13. The computer communications system of claim 12 wherein the network access device comprises a computer.


(refer to [0050] FIG. 1 illustrates an employee stock plan system 2. Stock plan system 2 comprises a finance system 4, a communication system 8 that connects a participant 10 to finance system 4 and a trading system 12 for the trading of individual transactions on a public exchange 28)

Claim 14. The computer communications system of claim 12 wherein the computer communication network conforms to the transmission control protocol/internet protocol.

[10] The communication system comprises conventional access technology such as an interactive voice response system (i.e., telephone interface), or an Internet or intranet interface.

Claim 15. The computer communications system of claim 12 wherein the communication network comprises an intranet.

[10] The communication system comprises conventional access technology such as an interactive voice response system (i.e., telephone interface), or an Internet or intranet interface.



Art Unit: 3624

Per Claim 16 Shields discloses a Computer executable program code residing on a computer-readable medium, the program code comprising instructions for causing the computer to:

transmit data relating to a restricted securities trade;

receive a Legal Opinion related to the trade;

receive electronic authorization to proceed with the trade;

and

transmit a command to execute trade.

(all limitations have been analyzed per claim 12.)

Claim 17. Per claim 17 Shields discloses a method of interacting with a network access device (Finance System 4, Figure 1) in order to complete an online transaction, the method comprising the steps of:

initiating interaction with a host computer via a communications network;

transmitting data related to a trade involving a restricted security;

[[0050] FIG. 1 illustrates an employee stock plan system 2. Stock plan system 2 comprises a finance system 4, a communication system 8 that connects a participant 10 to finance system 4 and a trading system 12 for the trading of individual transactions on a public exchange 28.)

Art Unit: 3624

receiving documentation related to the trade of the
restricted security; and
transmitting electronic authorization to conduct the trade.

[0014] ..a check and journal process associated with a system for administering at least one employee stock plan. The system includes a computer-implemented finance system for processing a transaction pursuant to the employee stock plan including a volatile data storage for storing participant information pursuant to a data transfer from a nonvolatile database of a third party administration system; and an interface system for interacting with participants regarding requested transactions..

[0086] interface system 38 provides the participant 10 the option to request an authorization form 160, e.g., by providing telephone touch key selections or, as shown in FIG. 5 for a web-based system, presenting selectable hypertext links on a display that allow the participant to complete and submit the form online, and capture an online signature.

Claim 18. The method of claim 17 additionally comprising the step of viewing a data stream content via a graphical user interface.

(refer to Figure 14 and para [0129] FIG. 14 illustrates an order entry display 370 that is presented to participant 10 to collect information for place order function 210 (FIG. 9).)

Art Unit: 3624

Per claim 22 Shield teaches a method of interacting with a network access device in order to complete an online transaction, the method comprising the steps of:

initiating interaction with a host computer via a communications network;

(refer to Figures 8-13 and related description)

transmitting data related to a trade involving a restricted security;

(Fig. 9 and para [0111] for details of transaction of restricted security)

receiving documentation related to the trade of the restricted security; and

(para [116] after cumulative order 208 is transmitted to trading system 12, interface system 38 logic allows participant 10 to access confirmation system 44 to confirm the order 222, repeat order information 224 or cancel/abort the order 226)

transmitting electronic authorization to conduct the trade.

(see above confirmation of the order)

Claim 23. A computer data signal as in claim 22 wherein the signal generated adheres to the transmission control protocol/Internet protocol.

(refer to claim 14 analysis)

Art Unit: 3624

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the

application indicating obviousness or nonobviousness.

2. Claims 6-8, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shields et al. (US 2002/0042771) (hereafter Shields) and further in view of existing business practices.

Claims 6-8: Shields fails to expressly teach that the generated documentation comprises a legal opinion, a broker's

Art Unit: 3624

letter, and a seller's letter. However, it is noted that the type of generated documentation (supportive of the trade) or the nature of the documentation does not functionally relate to the method steps receiving data, receiving electronic verification, automatically generating documentation and receiving signature because these steps are performed regardless of the nature of the documents being generated.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Shields to generate any type of documentation supportive of the trade because the subjective nature of the document does not functionally relate to the steps in the method claimed and because the subjective interpretation of the generated documents does not patentably distinguish the claimed invention.

Claims 19-21 are also analyzed in similar manner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

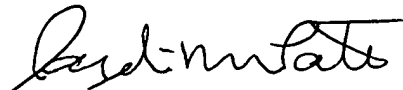
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the

Art Unit: 3624

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

12/9/04